

## REMARKS

### Summary of Applicant's Invention

Independent Claim 1 recites a memory device (3) for storing a data file and fingerprint reference data obtained by scanning a fingerprint of a person authorized to access the data file; a fingerprint sensor (4) for generating fingerprint scan data of a user of the claimed electronic data storage medium (1); an input/output interface circuit (5); a processing unit (2) operable selectively in (a) a programming mode, where the processing unit (2) activates the input/output interface circuit (5) to receive the data file and the fingerprint reference data from an external computer (9), and to store the data file and the fingerprint reference data in the memory device (3), and in (b) a data retrieving mode, wherein the processing unit (2) receives the fingerprint scan data from the fingerprint sensor (4), compares the fingerprint scan data with the fingerprint reference data in the memory device (3) to verify if the user of the electronic data storage medium (1) is authorized to access the data file stored in the memory device (3) and activates the input/output interface circuit (5) to transmit the data file to the computer (9) upon verifying that the user of the electronic data storage medium is authorized to access the data file stored in the memory device (3).

Dependent Claim 6 recites a function key set (8) operable so as to initiate operation of the processing unit (2) in a selected one of the programming and data retrieving modes.

In dependent Claims 7 to 10, the processing unit (2) is further operable selectively in a data resetting mode, where the data file and the fingerprint reference data are erased from the memory device (3) (Claim 7). Claim 8 recites a function key set (8) operable so as to initiate operation of the processing unit (2) in a selected one of the programming, data retrieving and data resetting modes. In Claim 9, the processing unit (2) compares an input password provided by the function key set (8) with a reference password stored in the memory device (3), and initiates operation in the data resetting mode upon verifying that the input password corresponds with the reference password. In addition, the processing unit (2) automatically initiates operation in the data resetting mode upon detecting that a preset time period has elapsed since storage of the data file and the fingerprint reference data in the memory device (3) in Claim 10.

#### **Response to Rejections Entered Against the Claims**

##### **Claim 1**

Claim 1 was rejected under 35 USC §102 as being anticipated by the Bjorn et al. U.S. Patent No. 6,125,192 (the '192 patent).

The '192 patent (see Figure 4) teaches a wallet (400), which belongs to a single owner, that includes a storage unit (430) for storing fingerprint data of the owner therein, a sensing unit (410) for generating fingerprint data of a user, a digitizer (420) for digitizing the user's fingerprint data, a matching unit (425) for matching the features of the user's fingerprint data to the owner's fingerprint data in the storage unit (430), a data flow control unit (435) for controlling access to data stored in a user data storage (440) upon verifying that the user's fingerprint and the fingerprint data match, and a control mechanism (445), such as a keyboard, mouse, trackball, touch pad, etc. In one embodiment, a system (a computer) enables a user to associate any file with his/her fingerprint after a successful fingerprint validation process (see Col. 16, lines 16-23).

While the '192 reference teaches that any file can be associated with the user's fingerprint after a successful fingerprint validation process, the '192 reference does not teach that data stored in the user data storage is received from an external data terminal upon operation of the data flow control unit in a programming mode. In contrast, the claimed invention recites a processing unit that is operable selectively in a programming mode for storing the data file and the

fingerprint reference data from an external data terminal in the memory device.

With more specificity, it was asserted that the limitation "an input/output interface circuit..." is met on column 6, lines 48-49 and 55-57 of the '192 patent. However, these passages are concerned with a control mechanism 445, such as a keyboard, mouse, trackball, touch pad, or a sensor 250, not an interface circuit. The difference is important because in both limitations in claim 1, the interface circuit receives a data file from the processing unit and receives fingerprint reference data from the data terminal. Obviously, there is no reason to send such data to the types of control devices contemplated by the '192 patent, nor does the '192 patent disclose that such data is in fact sent to the recited control devices.

With regard to the assertion that "a processing unit connected to said memory device, said fingerprint sensor and said input/output interface circuit, said processing unit being operable selectively" is met on column 6, lines 19-26, there is no disclosure of an interface circuit as set forth above, nor is there any disclosure of the processing unit being operable to select a programming mode or a data retrieving mode.

It is suggested that the "programming mode" limitation of claim 1 is met by column 6, lines 31-33 and 44-47 of the '192 patent. However, there is no disclosure in the '192 patent of

activating the input/output interface circuit as claimed in claim 1.

Similarly, with respect to the "data retrieving mode", which is said to be met on column 6, lines 28-43 of the '192 patent, there is no disclosure of activating an input/output interface circuit to transmit the data file to the data terminal upon verifying the user.

Thus, the '192 patent does not anticipate claim 1, nor is claim 1 obvious in view thereof.

**Claim 2**

Is asserted in the Office Action that data "card body" limitation is met on column 6, lines 19-27 of the '192 patent. It is not at all clear from this passage that the "wallet 400" is a card body. More importantly, there is absolutely no disclosure or contemplation of an input/output interface circuit in the '192 patent. Clearly, there is no anticipation of claim 2 by the '192 patent.

**Claims 3-5 and 11**

Various rejections were entered against these claims. Applicant submits that these claims are allowable as placing additional limitations on claims 1 and 2, which are allowable for the above-recited reasons.

#### Claim 6

This claim was rejected as anticipated under §102 in view of the '192 patent. Applicant submits that a fair reading of column 4, lines 13-14 simply discloses a keyboard. A keyboard typically has alpha-numeric keys. There is no disclosure of a function key set operable to select one of the programming and data retrieving modes as claimed in claim 6. There is therefore no anticipation of claim 6 by the '192 patent. In any event, claim 6 is dependent upon claim 1, which places further limitations on an allowable claim, as discussed above.

#### Claim 7

This claim was rejected as obvious under §103 based upon the '192 patent in view of Fernando et al. U.S. Patent No. 6, 193,152 (the '152 patent). The '152 patent teaches transaction security that is provided by causing data stored within a memory unit to be erased if tampering of the memory unit occurs.

In contrast, claim 7 is directed to selectively erasing the data file and the fingerprint reference data when in the data resetting mode. Erasure in the '152 patent is automatic upon determining that tampering has occurred not selective as claimed by the Applicant. Claim 7 is therefore not obvious in view of the '152 and '192 patents.

#### Claim 8

This claim was also rejected as obvious under 35 USC §103 based upon the '192 and '152 patents. As presented above, the '192 patent does not fairly teach or disclose a function key set, nor does the '152 patent teach selective erasure. Moreover, Claim 8 claims selective initiation of one of three modes, namely the programming, data receiving, retrieving or data resetting modes. Clearly, the combination of the '192 and '152 patents does not fairly teach or disclose such selective initiation of a plurality of modes.

#### Claim 9

This claim is rejected as obvious under 35 USC §103 based upon the '192 and '152 patents in view of U.S. Patent No. 6,321,478 (the '478 patent). The '478 patent is concerned with an intelligent controller for a firearm (gun).

Moreover, the '152 reference teaches erasing of data stored in the unit in the event of tampering, which is different from the limitations found in Claim 9, i.e., the processing unit compares an input password provided by the function key set with a reference password stored in the memory device, and initiates operation in the data resetting mode upon verifying that the input password corresponds with the reference password.

It is respectfully submitted that no one skilled in the art would be motivated to combine those references as suggested. In

any event, Claim 9 places further limitations on prior claims, including claim 1, which is believed to be in allowable form.

#### Claim 10

The claim is also rejected as obvious based upon a combination of the '192 and '478 patents. In particular, column 10, lines 12-19 of the '478 patent are cited. This passage teaches activating a fingerprint scanner for a predetermined time, such as 10 seconds. In contrast, claim 10 claims automatically initiating a data resetting mode upon elapse of a preset time period. The '478 patent is entirely different and claim 10 is not obvious in view thereof.

#### Petition for Extension of Time

Applicant petitions for a two-month extension of time to make the filing of this amendment timely. A check in the amount of \$210 is enclosed for a small entity.

#### The Abstract


The abstract was objected to as exceeding the allowable word limit. A replacement abstract is enclosed herewith on page 2 of this Amendment.



Conclusion

Reconsideration and withdrawal of the objections and rejections set forth in the Office Action are earnestly solicited. It is respectfully submitted that claims 1-11 define a patentable invention over the prior art. Early allowance is requested. The Examiner is invited to call the undersigned at the telephone number listed below concerning any matters which may advance the prosecution of this patent application.

Respectfully submitted,

  
Stephen B. Heller  
Registration No. 30,181

COOK, ALEX, MCFARRON, MANZO,  
CUMMINGS & MEHLER, LTD.  
200 West Adams Street - #2850  
Chicago, IL 60606  
(312) 236-8500